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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Benny et al.	:	Frejd, Russell Warren
Serial No.: 09/875,865	:	Group Art Unit: 2128
Filed: June 7, 2001	:	
	:	IBM Corporation
Title: ENTERPRISE SERVICE	:	Intellectual Property Law
DELIVERY TECHNICAL	:	11400 Burnet Road
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APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, which is the assignee of the entire right, title and interest in the above-identified patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 25-30 are pending in the Application. Claims 1-24 were cancelled. Claims 25-30 stand rejected. Claims 25-30 are appealed.

IV. STATUS OF AMENDMENTS

Appellants have not submitted any amendments following receipt of the final office action with a mailing date of November 20, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 25:

In one embodiment of the present invention, a method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer, comprising the step of identifying a Systems Management solution scope specific to an information technology environment of the customer. Specification, page 32, lines 1-5; Figure 2, step 202. The method further comprises inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope. Specification, page 32, lines 5-9; Figure 2, step 203. The method further comprises mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model. Specification, page 32, lines 10-21; Figure 2, step 204. The method further comprises identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope. Specification, page 33, lines 6-13. The method further comprises mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between

the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope. Specification, page 33, lines 14-22; Specification, page 34, line 15 – page 35, line 2.

Independent Claim 28:

In one embodiment of the present invention, a computer program product for storage on a computer readable medium, the computer program product operable for creating an information technology technical architecture comprising the program step of identifying a Systems Management solution scope specific to an information technology environment of the customer. Specification, page 32, lines 1-5; Specification, page 36, line 18 – page 37, line 11; Figure 2, step 202. The computer program product further comprises the program step of inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope. Specification, page 32, lines 5-9; Specification, page 36, line 18 – page 37, line 11; Figure 2, step 203. The computer program product further comprises the program step of mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model. Specification, page 32, lines 10-21; Specification, page 36, line 18 – page 37, line 11; Figure 2, step 204. The computer program product further comprises the program step of identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope. Specification, page 33, lines 6-13; Specification, page 36, line 18 – page 37, line 11. The computer program product further comprises the program step of mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery

technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope. Specification, page 33, lines 14-22; Specification, page 34, line 15 – page 35, line 2; Specification, page 36, line 18 – page 37, line 11.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 25-30 stand rejected under 35 U.S.C. §101.

VII. ARGUMENT

A. Claims 25-30 are not properly rejected under 35 U.S.C. §101.

The Examiner has rejected claims 25-30 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Office Action (11/20/2006), page 1. In particular, the Examiner asserts that claims 25-30 are rejected under 35 U.S.C. §101 because claims 25-30 are directed to a program per se and hence do not produce a useful, concrete and tangible result. Office Action (11/20/2006), pages 1, 2 and 5. Appellants respectfully traverse for at least the reasons stated below.

The Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. M.P.E.P. §2106. The subject matter courts have found to be outside the four statutory categories is limited to subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon. *See, e.g., Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874); M.P.E.P. §2106. Claims 25-27 are directed to a method, which is not outside the four statutory categories, for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer. Claims 28-30 are directed to a computer program product stored on a computer readable medium, which is not outside the four statutory categories, for creating an

information technology technical architecture. Using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer as well as creating an information technology technical architecture is directed to providing a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next. See Appellants' Specification, page 3, line 11 – page 4, line 3.

Appellants respectfully contend that the claimed inventions in claims 25-30 satisfy the test for statutory subject matter recited in *In re Alappat*, and repeated in *State Street Bank & Trust Co. v. Signature Financial Group*, and *AT&T Corp. v. Excel Communications, Inc.* *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1526, 50 U.S.P.Q.2d 1547 (Fed. Cir. 1999). The claimed inventions produce a useful, concrete and tangible result in, *inter alia*, providing a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next. For example, claims 25-27 produce a useful, concrete and tangible result in, *inter alia*, using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer. Claims 28-30 produce a useful, concrete and tangible result in, *inter alia*, creating an information technology technical architecture.

The essential inquiry under *In re Alappat* is to determine whether the claimed subject matter as a whole is directed to a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea" or if, in contrast, the mathematical concept has been reduced to some practical application rendering it useful. *AT&T Corp.*, 172 F.2d at 1357, 50 U.S.P.Q.2d at 1451 (citing *In re Alappat*, 33 F.3d at 1543, 31 U.S.P.Q.2d at 1556-57). Moreover, in making the determination whether the claimed subject matter as a whole is a disembodied mathematical concept or if the concept has been reduced to some practical application

rendering it useful, the claims must be construed in the light of the Specification. *See, AT&T Corp.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451 (stating that more than an abstract idea was claimed in *In re Alappat* because the "claimed invention as whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a *smooth wave form display*") (emphasis supplied). The single claim at issue in *In re Alappat* was directed to a rasterizer and recited elements in means plus function form. *In re Alappat*, 33 F.3d at 1540, 31 U.S.P.Q.2d at 1555. Additionally, none of the limitations recited in the claim at issue expressly claimed a "smooth wave form display". Indeed, the concrete, useful and tangible result relied upon in *In re Alappat*, namely, a smooth uniform display, appears in the background of the invention. *Kuriappan P. Alappat, et al.*, U.S. Patent No. 5,440,676 (col. 1, lines 9-10).

Likewise, in *AT&T Corp.*, the useful, nonabstract result relied upon in holding that the claimed invention was directed to statutory subject matter was that the PIC indicator therein held information about the call recipients PIC, which facilitated differential billing of long-distance calls made by a subscriber. *AT&T Corp.*, 172 F.3d 1358, 50 U.S.P.Q.2d at 1452. However, the claim at issue in *AT&T Corp.* was directed to a method including the steps of generating a message record for an interexchange call, and including in the message record a PIC indicator having a value which is a function of whether or not the interexchange carrier associated with the terminating subscriber is a predetermined one of the interexchange carriers. *AT&T Corp.*, 172 F.3d at 1354, 50 U.S.P.Q.2d at 1449. Again, there was no express or explicit claim limitation directed to the useful, concrete, and tangible result relied upon in determining that the aforesaid claim was directed to statutory subject matter. *See, Id.* The relied upon PIC indicator that facilitates differential billing of long-distance calls appears, *inter alia*, in the summary of the invention. *Gerard P. Doherty, et al.*, U.S. Patent No. 5,333,184, col. 1, line 66 through col. 2, line 3.

Likewise, in *State Street Bank & Trust v. Signature Financial Group*, a useful and concrete and tangible result not expressed in an explicit limitation in the claim at

issue was relied upon in holding that the claim was directed to statutory subject matter. *See, State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601 (holding that the transformation of data by the claimed data processing system produced a useful, concrete and tangible result, namely a final share price momentarily fixed for recording and reporting purposes). The claimed invention recited no limitation directed to either a final share price or means for momentarily fixing the final share price for recording and reporting purposes. *See, State Street Bank*, 149 F.3d at 1371, 47 U.S.P.Q.2d at 1599. Indeed, the relied upon useful, concrete and tangible result in *State Street Bank*, namely a final share price momentarily fixed, is not explicitly recited in the *State Street Bank* patent, but is effectively a distillation of the Summary of the Invention. *See, R. Todd Boes*, U.S. Patent No. 5,193,056, col. 4, lines 36-61. Thus, it is beyond peradventure that when judging the claimed subject matter as a whole to determine patentability under 35 U.S.C. § 101, the claims must be construed in the light of the specification.

In short, the question whether a claim encompasses statutory subject matter focuses on the essential characteristics of the subject matter, in particular its utility. *State Street Bank*, 149 F.3d at 1375, 47 U.S.P.Q.2d at 1602.

The Examiner contends that the cited claims do not produce a useful, concrete and tangible result. However, claims 25-30 clearly do produce a useful, concrete and tangible result. For example, referring to claim 25, claim 25 is directed to a method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer, which includes the steps of: identifying a Systems Management solution scope specific to an information technology environment of the customer; inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope; mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined

enterprise service delivery technical model; identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope; and mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope. These steps are directed to solving the need expressed in the Background section of Appellants' Specification, namely, providing a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next. See Appellants' Specification, page 3, line 11 – page 4, line 3.

Similarly, referring to claim 28, claim 28 is directed to a computer program product for storage on a computer readable medium for creating an information technology technical architecture, which includes the program steps of: identifying a Systems Management solution scope specific to an information technology environment of the customer; inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope; mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model; identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope;

and mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope. These program steps are directed to solving the need expressed in the Background section of Appellants' Specification, namely, providing a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next. See Appellants' Specification, page 3, line 11 – page 4, line 3.

As stated above, the inquiry under 35 U.S.C. §101 is whether there is a practical application, or result. *State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601. As discussed above, claims 25-30 are directed to a method and computer program product for providing a way for an outsourcing company to leverage from the knowledge gained while performing such outsourcing services from one client to the next. Hence, the subject matter of claims 25-30 has a practical application within the four statutory categories and is not an idea, a law of nature or a natural phenomenon.

Further, if the Examiner is asserting that software cannot be patented, Appellants respectfully traverse. Case law, including several cases decided by the Federal Circuit, has clearly established that software can be patented. For example, *In re Beauregard* clearly established that computer program product claims are patentable. *In re Beauregard*, 35 U.S.P.Q.2d 1383, 1384 (Fed. Cir. 1995). Claims 28-30 are directed to a computer program product for storage on a computer readable medium. These claim limitations are directed to the functionality embodied by the software and hence are patentable. Further, as discussed above, claims 25-27 are directed to a method producing a useful, concrete and tangible result.

Thus, Appellants respectfully contend that claims 25-30 constitute statutory subject matter. Appellants respectfully assert that the rejections of claims 25-30 under 35 U.S.C. §101 are in error.

VIII. CONCLUSION

For the reasons noted above, the rejections of claims 25-30 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 25-30.

Respectfully submitted,
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CLAIMS APPENDIX

25. A method for using an enterprise service delivery technical model to develop a technical framework to provide Systems Management services to a customer, comprising the steps of:

identifying a Systems Management solution scope specific to an information technology environment of the customer;

inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope;

mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model;

identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope; and

mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope.

26. The method as recited in claim 25, wherein the architectural building blocks and defined relationships between the architectural building blocks are a function of a set of predefined principles and key requirements.

27. The method as recited in claim 25, wherein relationships between the architectural building blocks are arranged in predefined logical levels.

28. A computer program product for storage on a computer readable medium, the computer program product operable for creating an information technology technical architecture comprising the program steps of:

- identifying a Systems Management solution scope specific to an information technology environment of the customer;

- inventorying existing information technology and Systems Management components supporting the information technology environment of the customer that are within the Systems Management solution scope;

- mapping the existing information technology and Systems Management components supporting the information technology environment of the customer to architectural building blocks of a predetermined enterprise service delivery technical model;

- identifying which architectural building blocks of the predetermined enterprise service delivery technical model are required to deliver the Systems Management services to the customer in accordance with the Systems Management solution scope; and

- mapping the inventoried existing information technology components that were mapped to the architectural building blocks of the predetermined enterprise service delivery technical model to the architectural building blocks of the predetermined enterprise service delivery technical model that were identified as required to deliver the Systems Management services in accordance with the Systems Management solution scope, this mapping step resulting in a list of design objects and relationships between the design objects that will deliver the Systems Management services in accordance with the Systems Management solution scope.

29. The computer program product as recited in claim 28, wherein the architectural building blocks and defined relationships between the architectural building blocks are a function of a set of predefined principles and key requirements.

30. The computer program product as recited in claim 28, wherein relationships between the architectural building blocks are arranged in predefined logical levels.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.

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